

REMARKS

During a telephone conversation on March 18, 2004, between counsel for the applicants and the patent examiner, a provisional election was made to pursue the invention of Group I (claims 1-18 and 60-62). The undersigned attorney for Applicants hereby affirms this election of the Group I claims, and has cancelled the non-elected claims (claims 19-59) without prejudice.

In the Office Action dated April 29, 2004, claims 1-11, 13-18 and 60-62 were rejected under 35 U.S.C. 103(a) as being unpatentable over Szlam et al. (US 2002/0047859 A1), in view of Beck et al. (6,170,011 B1). Claim 12 was rejected under 35 U.S.C. 103(a) as being unpatentable over Szlam and Beck, and further in view of England (6,144,991).

The claims of the present application are generally directed to a method for selling goods and services in conjunction with a communication medium, such as the Internet. Session information corresponding to a customer's session is received from a website, customer information is received, a sales opportunity is determined, the customer is matched with a sales associate, communication between the customer and matched sales associate is facilitated, sales information is received, and all of this information is provided to the sales associate based upon the particular sales opportunity.

As amended, all of the pending claims recite that the session information corresponds to the customer's session on either a selected one of a plurality of websites, or the plurality of websites taken together. Moreover, all of the amended claims now recite that the sales associate is independent from the plurality of enterprises or websites.

Szlam teaches a dynamic help technique for Internet customers. Specifically, Szlam discloses automatically determining (using various factors) when a customer browsing a web site should be provided assistance by a customer service representative (CSR), and automatically connecting the customer to a CSR when the CSR is available or predicted to be available.

Importantly, the customer service representative (CSR) identified in Szlam appears to work for the company that operates the web site. The Examiner states that "...Szlam does not specifically disclose ... whether the sales associates are employed by the enterprise or are independent of the enterprise." Office Action, April 29, 2004, page 7. In fact, in the Background Section of Szlam, a customer service representative (CSR) is described as being associated with "the company". Szlam, Paragraph 0004, first sentence.

The Examiner thereafter cites Beck, stating that Beck discloses a

distributed topology where a single communication center may span multiple physical locations, a segmented communication center where a single pool of agents services more than one company or customer base, or a wide communication network where a plurality of communication centers cooperatively service a common pool of customers of a customer base.

Office Action, April 29, 2004, page 7.

The Examiner concludes that it would have been obvious to one of ordinary skill in the art to "have utilized a single web site or a plurality of web sites to determine the sales opportunity as disclosed in Beck [and] Szlam, as it is an enterprise business decision based upon business rules as taught in Beck." Based upon this conclusion, its not clear under what rational the Examiner combined Szlam and Beck.

The Court of Appeals for the Federal Circuit has held that "a *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993), quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). However, the mere fact that the prior art may be modified in the manner suggested by the Examiner neither makes the modification *prima facie* obvious nor obvious unless the prior art suggests the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). *See also In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) ("the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggest the desirability of the combination."); *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.") (citing *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

Even assuming for argument's sake that all of the limitations of the rejected claims are disclosed somewhere in either Szlam or Beck (an assumption that doesn't appear to be supported), the Examiner has clearly not set forth a *prima facie* case of obviousness, as required by 35 U.S.C. 103 and case law precedent. The Examiner has cited no suggestion to combine the Szlam and Beck references, which would apply to the claims as amended. On page 7 of the Office Action the Examiner states that Beck discloses "a segmented communication center

where a single pool of agents services more than one company or customer base”. However, the Examiner provides no suggestion in Beck as to how this may be combined with Szlam.

Moreover, where obviousness is based upon a modification of a reference that destroys the intended purpose or function disclosed in a reference, there is no motivation to engage in the modification. See *Schneider (Europe) AG v. Scimed Life Sys., Inc.*, 852 F. Supp. 813 (D. Minn. 1994). See also *In re Fritch*, 23 U.S.P.Q.2d at 1783 n.12 ("This court has previously found a proposed modification inappropriate for an obviousness inquiry when the modification rendered the prior art reference inoperable for its intended purpose.") (citing *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)). On page 5 of the Office Action, the Examiner concedes that Beck is directed to “outbound campaigns” – mass calling campaigns initiated by a call center. This is an entirely different environment than the present invention, whereby customers browsing a website are matched with a sales associate – i.e., the communication initiated through the customer’s actions *vis-a-viz* one or more web sites.

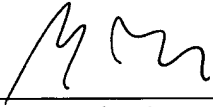
Thus, with respect to the rejection of claims 1-11, 13-18 and 60-62, a *prima facie* case of obviousness has not been made, and the rejection is therefore improper.

With respect to the rejection of claim 12 over Szlam and Beck in view of England, the Examiner cites England as disclosing the ability for a sales associate to manipulate the customer’s navigation of the Internet. As explained previously, a *prima facie* case of obviousness has not been made with respect to Szlam and Beck, and the addition of England does not change this analysis. Thus, the rejection of claim 12 is also improper.

In view of the foregoing, the present patent application is now deemed to be in condition for allowance. Applicants therefore respectfully request formal allowance of the application. If the Examiner believes further discussion of any issue would expedite allowance, the Examiner is encouraged to telephone Applicants' undersigned representative.

Respectfully submitted,

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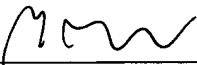


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Gregory J. Kirsch

2 AUGUST 2004
Date